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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Damon H. DeHart

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EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,867	Applicant(s) DEHART, DAMON H.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 63-67 is/are pending in the application.
- 4a) Of the above claim(s) 32-41, 54, 55, 59 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 63-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In previous Office action, claims 1-10, 32-41, 54-55, 59-60 and 63-66 were pending in this present application, claims 32-41, 54, 55, 59 and 60 have been withdrawn and Claims 1-10 and 63-66 were examined and rejected.

Response to Amendment

2. Applicant's arguments filed on April 14, 2008 that Ayres fails to disclose a holder arranged and configured to hold the lancet and move the lancet to penetrate the skin of a patient have been fully considered but they are not persuasive. Ayres discloses (Figure 5) a holder 22 couples to the double end needle as shown in Figures 1-4 and 7 (col. 1, lines 1-2 and col. 2, lines 1-2). With respect to the limitation that the holder is configured to move the lancet to penetrate the skin of a patient, noting that the Vacutainer tube 22 (Background of The Invention and Fig. 5), which also includes the needle, is held and moved by a healthcare provider to penetrate a patient skin to withdraw blood sample (Background of the invention), thus, the needle is moved by Vacutainer tube 22 or holder 22. Thus, Ayres discloses the holder 22 is configured to move the needle or lancet to penetrate the skin of a patient.
3. According to the amendment, claim 67 is new. Accordingly, claims 1-10, 32-41, 54-55, 59-60 and 63-67 are pending in this present application. Claims 32-41, 54, 55, 59 and 60 have been withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-10 and 63-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Ayres (U.S. 3,906,932).**
6. Referring to claims 1-6 and 63-66, Ayres discloses (see Figs. 1-5 and 7) a cylindrical needle 10 and holder 22 (Fig. 5), that is capable to use as a lancet device, comprising: a seamless unitary member which is hollowed along at least a portion of its length wherein the needle including first and second ends wherein the first end further includes a first and second sharpened tips 16, 18 that are created by a pair of bevel faces 12 or planar faces and a Vacutainer tube 22 (Background of The Invention) or holder 22 (see col. 2, lines 18-65). With respect to the limitation that the holder is configured to move the lancet to penetrate the skin of a patient, noting that the Vacutainer tube 22 (Background of The Invention and Fig. 5), which also includes the needle, is held and moved by a healthcare provider or a user to penetrate a patient skin to withdraw blood sample (Background of the invention), thus, the needle is moved by Vacutainer tube 22 or holder 22. Thus, Ayres inherently discloses the holder 22 is configured to move the needle or lancet to penetrate the skin of a patient.

7. Referring to claim 3, the limitation of “first and second ground surfaces which at least partially define first and second sharpened tips” is product-by-process claims. Referring to claim 64, the limitation of “the first tip and the second tip are at least partially defined by first and second ground surfaces” is product-by-process claims. Here it is noted that a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S. P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3.
8. Referring to claims 7-10, Ayres discloses (Fig. 7) the first ground surface 12 and second ground surface 14 is a single angle ground surface and each of the ground surface extends from the horizontal plane at an acute angle relative to the longitudinal axis. Figures 3 and 7 show the first and second ground surfaces 12, 14 mirror one another about the horizontal plane and each ground surface extends approximately 180 degrees about the longitudinal axis.
9. Referring to claim 67, Ayres discloses the needle for penetrating rubber stopper of the holder 22 (Fig. 5 and col. 2, lines 18-30), thus, Ayres inherently discloses the needle is rigid.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731